

REMARKS

I. Status of the Claims

Claims 1-15 are pending in the present application. .

Claims 1-15 currently stand rejected.

II. Claims

Claims 1-15 have been amended as suggested by the Office to more particularly point out what the applicant considers as their invention. Support for the amendments can be found throughout the specification. The claims as originally drafted and now as amended are fully enabled and supported by the specification.

IV. Rejection under 35 U.S.C. §112, First Paragraph

Claim 1-15 stands rejected under 35 U.S.C. §112. The applicant respectfully traverses the Office's claim that the claims are not enabled because the claimed invention is fully enabled as claimed. The applicant need not supply examples for every possible subspecies in the related chemical reactions to avoid a rejection. Therefore applicant respectfully requests reconsideration and allowance of all claims now as currently amended.

V. Rejection under 35 U.S.C. §112, Second Paragraph

Claims 1-15 have been rejected under 35 U.S.C. §112, second paragraph. This rejection is respectfully traversed. The claims as previously submitted are

definite and particularly point out the applicant's invention. For purposes of clarification only to aid the Office, the above-cited claims have been amended to clearly point out the applicant's instant invention as fully supported by the specification and thus fully satisfying the Office's requirements.

V. Rejection under 35 U.S.C. §103(a)

Claims 1-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jackson (6093827). The applicant respectfully requests reconsideration and allowance of claim 1-15 because applicant has properly made a translation of foreign priority documents that are resubmitted with this response to aid the Examiner. The proper claiming of foreign priority therefore removes the Jackson reference.

Claims 1-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pinwinski II (5089496, PTO-1449) in view of Cid. The applicant respectfully disagrees with the Examiner because the combined teachings of the cited references fail to provide the instant invention.

Specifically Pinwinski II fails to disclose in columns 1-3 the instant compound as purported by the Examiner. The Pinwinski II reference in columns 1-3 specifically discloses a tri-cyclic ring system, wherein the central ring has seven (7) members. However, the instant invention has six (6) members in its central ring. Therefore because the Pinwinski II reference fails to disclose the same

structure it fails to form a valid Prima facie rejection either singularly or in combination with the Cid. reference.

The applicant therefore respectfully requests removal of the obviousness rejection and allowance of claims 1-15.

V. Rejection under 35 U.S.C. §102(b)

Claim 15 stand rejected under 35 U.S.C. §102(b) as being anticipated by Pinwinski I (WO 89/10369, PTO-1449) because of compounds disclosed, specifically “compounds E,F,G” displayed on pages 54-55 and 64-66. The applicant respectfully traverses the Examiner’s rejection.

Applicant contends that the “compound E” is not claimed and therefore not anticipated. Applicant draws examiner’s attention to claim 1, which claim 15 is dependent therefrom only, specifically the definition for the Groups Z and R¹. The applicant directs examiner’s attention specifically to Z¹ which fails to recite a methyl group. Therefore without the methyl group it fails to encompass “Compound E” of Pinwinski I.

Applicant contends that “compound F” is not claimed in claim 1 and therefore not claimed in dependent claim 15. The applicant wishes to draw the examiner’s attention to claim 1, specifically for the definition of Groups Z and R¹. The applicant then directs the examiner towards the specific element of -C(O)OR¹ from substituent Z. For Claim 15 to anticipate “compound F” the R¹ substituent must be

an ethyl group. The applicant does not claim a methyl group in R¹ thus the “compound F” is not encompassed by claim 15.

Applicant contends that “compound G” is not claimed in claim 1 and therefore not claimed in dependent claim 15. The applicant wishes to draw the examiner’s attention to claim 1, specifically for the definition of Groups Z and R¹. The applicant then directs the examiner towards the specific elements disclosed in R¹. For Claim 15 to anticipate “compound G” the R¹ substituent must be a Hydrogen group. The applicant does not claim a Hydrogen group in R¹ thus the “compound G” is not encompassed by claim 15.

Pinwinski I examples “E, F, and G” on page 64-66 also fails to anticipate the instant invention. Pinwinski I discloses a seven membered central ring, however the instant invention claims a six membered central ring. Therefore claim 15 cannot be anticipated by what it does not claim.

Claim 15 stands rejected under 35 U.S.C. §102(b) as being anticipated by Pinwinski II (5089496, PTO-1449) by the compounds described on columns 71-74, specifically table IV. The applicant respectfully disagrees with the rejection because claim 1 and respectively dependent claim 15 fails to claim the compounds disclosed in Table IV of Pinwinski II.

Claim 15 does not claim the compounds of Table IV of Pinwinski II, to make the comparison as clear as possible the applicant directs the examiner towards formula (I) of the instant application. The instant invention claims a tri-cyclic ring

combination having a substituent Y. The substituent Y is on a six-membered central ring, whereas the compound disclosed in Table IV is clearly displayed with a 7(seven) member central ring. Therefore it is clearly a different compound regardless of what Table IV discloses for their disclosed Z and R substituents.

Claim 15 stands rejected under 35 U.S.C. §102(b) as being anticipated by Wong I (EP 515158, PTO-1449) by the compounds disclosed on pages 22-23, specifically compounds F, G, and Example 1. The applicant respectfully disagrees with the Examiner's rejection because claim 1 and respectively dependent claim 15 fails to claim the compounds disclosed in pages 22-23 of Wong I.

The applicant will attempt to make the comparison as clear as possible and therefore the applicant directs the examiner towards formula (I) of the instant application. The instant invention claims a tri-cyclic ring combination having a substituent Y. The substituent Y is on a six-membered central ring, whereas the compound disclosed in page 22-23 is clearly displayed with a 7(seven) member central ring. Therefore it is clearly a different compound regardless of what it discloses for their substituents.

Claim 15 stands rejected under 35 U.S.C. §102(b) as being anticipated by Wong II (EP 524784, PTO-1449) by the compounds disclosed on pages 21. The applicant respectfully disagrees with the Examiner's rejection because claim 1 and respectively dependent claim 15 fails to claim the compounds disclosed in pages 21 of Wong II.

The applicant will attempt to make the comparison as clear as possible and therefore the applicant directs the examiner towards formula (I) of the instant application. The instant invention claims a tri-cyclic ring combination having a substituent Y. The substituent Y is on a six-membered central ring, whereas the compound disclosed in page 21 is clearly displayed with a 7(seven) member central ring. Therefore it is clearly a different compound regardless of what it discloses for their substituents.

Therefore claim 15 is clearly not anticipated and therefore patentable because the instant application does not claim any compounds disclosed in the cited prior art. The applicant thus respectfully requests the rejection be removed and allow the claim.

V. Rejection under 35 U.S.C. §102(e)

Claims 1-13, 15 stand rejected under 35 U.S.C. §102(e) as being anticipated by Jackson (6093827). The applicant furnishes a second certified translation copy for the file and hereby claim foreign priority. Therefore the rejection is overcome through a proper claiming of foreign priority.

Claims 1-13, 15 stand rejected under 35 U.S.C. §102(e) as being anticipated by Stampa (6084100). The applicant furnishes a second certified translation copy for the file and hereby claim foreign priority. Therefore the

rejection is overcome through a proper claiming of foreign priority. The applicant thus respectfully request reconsideration and allowance of claims 1-13, and 15.

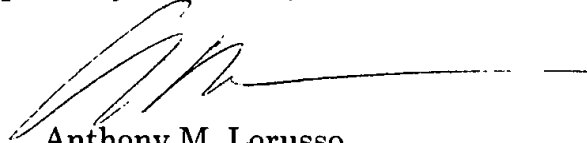
I. Conclusion

The applicant thus contends that the disclosures cited and combined by the Office fail to provide either a suggestion or the required motivation in the art to produce the applicant's instant invention. The Office fails to provide a prima facie case of obviousness because

Therefore the combination of Office's cited disclosures fail to include all the required limitations of the claimed invention without improperly using hindsight or the applicant's disclosure.

In view of the cited disclosures and the remarks made by applicant, Claims 1-15 are in condition for allowance. Accordingly, an early notification of allowance is courteously requested. Feel free to contact this office collect if you wish to discuss the application.

Respectfully submitted,



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